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September 6, 2006
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lipstik, Inc.

Serial No. 76623522

Michael A. Painter of Isaacman, Kaufman & Painter for Lipstik, Inc.

S. Michael Gaafar, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Quinn, Hohein and Cataldo, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Lipstik, Inc., by assignment from Goat Wear, Inc., is the owner of an application to register on the Principal Register in standard character form the mark "EVERY GIRL WANTS TO WEAR LIPSTIK" for "beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits, jumpers, leg warmers, leggings, lingerie, loungewear, neckwear, pants, scarves, shirts, ski wear, slacks, sleepwear, T-shirts, tank tops, socks, [and] vests" in International Class 25.¹

¹ Ser. No. 76623522, filed on December 7, 2004, which alleges a date of first use anywhere and in commerce of January 2001. Applicant claims ownership of Reg. No. 2,943,570, issued on April 26, 2005, for the mark "LIPSTIK GIRLS" and design for the same goods as those set forth herein.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "LIPSTICK," which is registered on the Principal Register in standard character form for "junior apparel, namely, slacks, jeans, shorts, skirts, dresses, blouses, knit tops, halters, swimwear, robes, sweaters, coats, jackets, rainwear, vests, scarves, belts, socks and hosiery,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested. We affirm the refusal to register.

² Reg. No. 2,218,837, issued on January 19, 1999, which sets forth a date of first use of the mark anywhere of October 1, 1997 and a date of first use in commerce of December 1, 1997; combined affidavit §§8 and 15.

³ The Examining Attorney, in his brief, "objects to the pending application (Ser. No. 76/399,500) referenced in the applicant's ... [brief] because the applicant failed to make such application properly of record." According to the Examining Attorney, "[r]egistrations and pending applications may be made of record when accompanied by legible, soft copies of the registrations [and applications] themselves or the electronic equivalent thereof," citing *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992). Here, the Examining Attorney asserts, inasmuch as "the applicant has not proffered copies of the pending application, it is not ... considered part of the record," citing *In re Hungry Pelican, Inc.*, 219 USPQ 1202, 1204 n.5 (TTAB 1983); *In re Delbar Products, Inc.*, 217 USPQ 859, 861 (TTAB 1981); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). The Examining Attorney also "objects to the pending application (Ser. No. 78/399,500) [sic] referenced in the applicant's ... [brief] on the additional grounds that the present submission of such document as an exhibit is untimely," arguing that "[e]xhibits that were not properly made of record during examination are untimely when submitted with an appeal, and, absent prior stipulation into the record, generally will not be considered." We note, however, that in its response to the initial Office action, applicant in its remarks not only indicated that it "is the owner of the registered trademark LIPSTIK GIRLS [and design] which is registered for the purpose of designating the same goods identified in this application," but stated that, "[i]n addition, Applicant is the owner of the allowed application Serial No. 76/399,500 to register LIPSTICK [sic] GIRLS [and design] in

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁴ Here, due to the broad manner in which applicant's items of apparel are identified,⁵ it is plain that its goods are either in part legally identical to certain of registrant's items of "junior apparel" (e.g., "blouses," "coats," "dresses," "jackets," "jeans," "scarves," "socks" and "vests") or are otherwise closely

International Classes 3 and 14." Inasmuch as the Examining Attorney, in his final refusal issued in response, raised no objection to applicant's failure to include a copy of such application with its response, the Examining Attorney's objections are considered waived. It is nonetheless pointed out that, in any event, applicant's application Ser. No. 76399500 for the mark "LIPSTIK GIRLS" and design is evidence only of the filing thereof and is otherwise without any probative value with respect to the registrability of the subject mark in this application.

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

⁵ It is well established that the issue of likelihood of confusion is determined on the basis of, among other things, the goods as they are identified in the application and cited registration, without limitations or restrictions that are not reflected therein. See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

related thereto in a commercial sense, and thus the respective goods would necessarily be sold through the same channels of trade to the same classes of customers,⁶ the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective marks.

Turning, therefore, to such issue, applicant in its brief contends that "the position taken by the Examiner totally fails to consider that Applicant is the owner of the registered trademark LIPSTIK GIRLS & Design (Registration No. 2,943,570) which is registered for the purpose of designating the same goods [as] identified in the subject application." Applicant, in particular, insists that:

The weakness of the cited reference is evident from the action taken by the Office in connection with Appellant's pending application and its registered trademark. In the prosecution of the Appellant's application to registration of LIPSTIK GIRLS & Design, the Examiner initially refused registration on the same basis as now asserted in this application (i.e., Registration No. 2,218,837 for the mark LIPSTICK). Most importantly, in response to Appellant's position that LIPSTIK GIRLS was clearly distinguishable from the reference when the marks were considered in their entirety, the position of the Examiner was withdrawn and the mark LIPSTIK GIRLS [& Design] registered in International Class 25 on April 26, 2005.

⁶ Applicant, we observe, does not contend otherwise in its brief. In any event, it is well settled that a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the goods listed in the application and any of the goods set forth in the cited registration. See, e.g., Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and Shunk Mfg. Co. v. Tarrant Mfg. Co., 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).

Applicant argues, in view thereof, that because it presently "owns the registered mark LIPSTIK GIRLS & Design for precisely the same goods identified by the subject mark" herein, its "Registration No. 2,943,570 and the prosecution history thereof constitute probative evidence in this matter to show the scope of protection to be afforded the mark relied upon by the Examiner is limited."

Applicant further contends that "[w]hen comparing marks, the test is overall impression, not a dissection of individual features," inasmuch as "the marks must be compared in their entirety" (underlining in original). Applicant therefore urges that confusion is not likely because (footnotes omitted; underlining in original):

The words "EVERY GIRL WANTS TO WEAR" are an integral part of Applicant's composite mark. The Examiner has ignored the most important fact: the subject mark incorporates Applicant's registered mark LIPSTIK GIRLS, not the mark comprising the reference. A mark must still be regarded as a whole in evaluating similarity to other marks. [In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985).] The refusal to register the subject mark fails to consider the commercial impression of all portions of Applicant's composite mark. There is no general rule as to which feature of a mark will dominate. However, the Federal Circuit has established a principle which is applicable in this case:

"No element of a mark is ignored
simply because it is less dominant,
or would not have trademark
significance if used alone."
(Emphasis added[.])

[In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).] Where non-common portions of marks are sufficient to distinguish the marks as a

whole, the inclusion of a common element may be insufficient to predicate a holding of confusing similarity. [Red Carpet Corp. v. Johnston American Enterprises Inc., 7 USPQ2d 1404, 1406 (TTAB 1988).]

We agree with the Examining Attorney, however, that confusion is likely. As a preliminary matter, we note that "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines," Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), and that, as correctly pointed out by the Examining Attorney in his brief, the same is likewise true with respect to closely related goods. See In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); and ECI Division of E-Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443, 449 (TTAB 1980). Moreover, we observe that the word "LIPSTICK," which constitutes registrant's mark, and the phonetic equivalent thereof, namely, "LIPSTIK," which forms a significant portion of applicant's "EVERY GIRL WANTS TO WEAR LIPSTIK" mark, are arbitrary or fanciful terms when used in connection with items of wearing apparel and thus, unlike suggestive designations, are strong indicators of product source.

As the Examining Attorney persuasively contends in his brief, "[a]lthough the applicant's mark employs a non-traditional spelling of the term 'lipstick,' the difference between the terms 'lipstick' and lipstik' is minor, and the pronunciation of the term remains unchanged." In fact, to us, the difference in such terms is barely perceptible, even on the basis of a side-by-side

comparison of the marks at issue,⁷ and the ordinary consumer would find it difficult to distinguish such terms.⁸ Furthermore, we concur with the Examining Attorney's additional contention that:

[T]he structure of the applied-for mark in relation to the registered mark provides a commercial impression such that consumers are likely to believe that identical goods offered in connection with the marks at issue emanated from a common source. When viewing or hearing the applied-for mark, consumers are likely to interpret it to mean, "every girl wants to wear LIPSTICK [brand clothing]," rather than denoting a separate and unique source of goods.

Noting, with respect thereto, that "[a]s evidence of the confusing nature of the applied-for mark, the Examining Attorney [has] previously attached evidence gathered from internet [sic] research that indicated use of the phrase 'everybody [or a gender specific variation thereof] wants to wear' prior to a specific brand name or retailer specific item or brand of clothing, such as Armani or Jordan," the Examining

⁷ A side-by-side comparison of the respective marks, of course, is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

⁸ Even applicant, as noted in footnote 5 of this opinion, mistakenly referred in its response to the initial Office action to being "the owner of the allowed application Serial No. 76/399,500 to register LIPSTICK [sic] GIRLS [and design] in International Classes 3 and 14."

Attorney insists that "[b]ecause usage of the phrase 'everybody wants to wear' has become prevalent in consumer culture, consumers are likely to view the phrase 'every girl wants to wear lipstick' as an elaboration or marketing slogan referring to the currently registered mark LIPSTICK, rather than serving as an indicator of a unique source of goods." Such evidence consists, in relevant part, of the following six examples from an Internet search conducted on November 14, 2005 (emphasis added):⁹

"Now that's groovy! **Everybody wants to wear** a CyberDodo's baseball cap!" -- www.toyshop.uptoten.com/product_info.php?products_id=70;

"Which is why, quite simply, **everybody wants to wear** an Arai [motorcycle crash] helmet. After all, why settle for anything less than the best?" -- www.sportbikeshop.co.uk/motorcycle_parts/content_cat/2;

"Commenting on the ongoing trend of a ready acceptance of designer wear, Zahir feels that, 'It is a worldwide phenomenon.' He adds, 'As the mid income group grows their need for identification grows. This is happening in Pakistan too. **Everybody wants to wear** a Boss suit or an Armani shirt, because it is a sense of identification of having reached a certain standard. It's all marketing." -- www.jang.com.pk/thenews/mar-2003-weekly/nos-30-03-2003/instep.htm;

"'If Michael Jordan wears Nikes, **everybody wants to wear** Nikes,' Singer

⁹ While three of the six excerpts are obviously from foreign websites (specifically, the United Kingdom, Pakistan and Taiwan as respectively indicated by the terms "uk," "pk" and "tw"), we have considered such evidence inasmuch as it is as readily available to consumers in the United States as are the three other excerpts of record from websites which are based in the United States. See generally, In re Cell Therapeutics Inc., 67 USPQ2d 1795, 1797-98 (TTAB 2003) ["we believe that communications have changed dramatically ... such that by now it is by no means uncommon for even ordinary consumers ... to receive news not only via tangible newspapers and magazines, but also electronically through personal computers"].

continues." -- rgp.ufl.edu/publications/-explore/v03n1/excerc.html;

"TRENDY PROCESS DEVELOPMENT LTD.
EVERYBODY WANTS TO WEAR KNITS!! We have 10
years Exporting Experience!!!" -- www.trendy-com.tw/woven.htm; and

"**Everybody wants to wear** the famous Cat
in the Hat hat." -- www.nea.org/readacross/-basics.html.

Here, it is plain that in terms of overall commercial impression, applicant's "EVERY GIRL WANTS TO WEAR LIPSTIK" mark creates a double entendre in that it not only has its literal meaning of "EVERY GIRL WANTS TO WEAR LIPSTICK," that is, the cosmetic product, but as the Examining Attorney has pointed out, and given that the terms "LIPSTIK" and "LIPSTICK" are virtually indistinguishable in sound, appearance and meaning, such mark also readily projects the connotation, especially to those who are familiar with or have otherwise heard of registrant's "LIPSTICK" brand junior apparel, that "EVERY GIRL WANTS TO WEAR LIPSTICK," that is, registrant's "LIPSTICK" brand of junior apparel. Confusion is thus likely from contemporaneous use of the mark "EVERY GIRL WANTS TO WEAR LIPSTIK" by applicant for various items of wearing apparel and the mark "LIPSTICK" by registrant for articles of junior apparel.

Finally, as to applicant's argument that confusion is not likely and that it is entitled to registration of its "EVERY GIRL WANTS TO WEAR LIPSTIK" mark in view of the fact that its Reg. No. 2,943,570 for the mark "LIPSTIK GIRLS" and design, as shown below,



registered over the same registration for the mark "LIPSTICK" as has been cited as a bar to registration herein, the Examining Attorney maintains that "applicant's position is contrary to the longstanding, well-settled precedent indicating that prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office." According to the Examining Attorney:

Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, [474 F.2d 1403,] 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978).

The Examining Attorney is correct. As our principal reviewing court observed in, for instance, *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court." See also, *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991). Applicant's prior registration, therefore, does not justify allowance of the registration which it presently seeks.

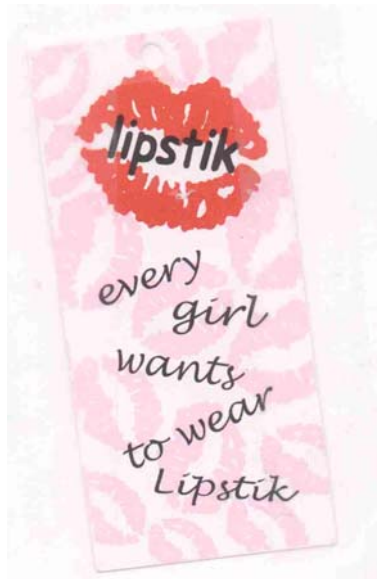
Moreover, the Examining Attorney points out that in any event:

[I]n response to the applicant's arguments as to the mark in ... Registration No. 2,943,570, it should be noted that there are significant differences in the appearance of the currently applied-for mark and the referenced mark. In the registration referenced by the applicant, the mark is presented in a highly stylized format, with the focus of such mark being the large depiction of a pair of lips. The wording "lipstik girls" appears in a highly cursive font inside the pair of lips and the wording is partially obscured by the image of the lips. Because the placement and font of such wording, the wording can appear to be, upon cursory review of the mark, a depiction of teeth inside the lips, as opposed to wording serving an independent source indicating function. The highly stylized mark therefore has little bearing on the relative "weakness" ... of the registration cited by the examining attorney.

In addition, we note that allowance of applicant's "LIPSTIK GIRLS" and design mark over the registration for the "LIPSTICK" mark cited herein is arguably explained not only by the presence in the former of the prominent pair of lips incorporated therein as a design feature, but by the additional term "GIRLS," which is lacking in the "LIPSTICK" mark. See *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) [due to the "significant contribution from the component 'girl,'" the marks "VARGA GIRL" and "VARGAS," both for calendars, "are sufficiently different in sound, appearance, connotation, and commercial impression, [as] to negate likelihood of confusion"].

Lastly, we further observe that contrary to applicant's argument that "[t]he Examiner has ignored the most important fact: the subject mark incorporates Applicant's registered mark

LIPSTIK GIRLS," it is plain that its subject "EVERY GIRL WANTS TO WEAR LIPSTIK" mark does not include its "LIPSTIK GIRLS" and design mark. Applicant, as shown by the specimen of use of its applied-for mark, which is reproduced below,



instead actually uses a "LIPSTIK" and design logo in conjunction with its "EVERY GIRL WANTS TO WEAR LIPSTIK" mark. Such use clearly serves to enhance the likelihood of confusion of its applied-for mark with the cited registrant's "LIPSTICK" mark.

Accordingly, we conclude that consumers, who are familiar or acquainted with the cited registrant's "LIPSTICK" mark for its "junior apparel, namely, slacks, jeans, shorts, skirts, dresses, blouses, knit tops, halters, swimwear, robes, sweaters, coats, jackets, rainwear, vests, scarves, belts, socks and hosiery," would be likely to believe, upon encountering applicant's similar "EVERY GIRL WANTS TO WEAR LIPSTIK" mark for its "beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits, jumpers, leg warmers, leggings,

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lingerie, loungewear, neckwear, pants, scarves, shirts, ski wear, slacks, sleepwear, T-shirts, tank tops, socks, [and] vests," that such legally identical in part and otherwise closely related goods emanate from, or are sponsored by or affiliated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.